

REMARKS

Summary of the Office Action

Claims 15-17, 26, 32-33, and 48-50 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,088,323 to Kobayashi et al. (hereinafter "Kobayashi").

Claims 18, 21, 31, 34-37, 42-45, 47 and 51 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kobayashi in view of U.S. Patent No. 4,967,286 to Nomula et al. (hereinafter "Nomula"). Both Kobayashi and Nomula were applied in the previous Office Action dated April 4, 2003.

Claims 19, 20, 22-25, 27-30, 38-41 and 46 stand objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Summary of the Response to the Office Action

Applicants have amended independent claims 15, 32, 47 and 48, and added two new independent claims 56-57.

Accordingly, claims 15-51 and 56-57 are pending for further consideration.

Allowable Subject Matter

The Examiner is thanked for indicating at Page 5 that claims 19, 20, 22-25, 27-30, 38-41 and 46 include allowable subject matter. However, Applicants respectfully submit that the

Office Action's objection to claims 19, 27, 29 and 30 is incorrect because these claims were already rewritten in independent form in the previous Amendment filed on July 31, 2003.

Therefore, Applicants respectfully request that the objection to claims 19, 27, 29 and 30 should be withdrawn. There claims are in prima-facie condition for allowance in light of the April 4, 2003 and October 14, 2003 Office Actions' indications of allowable subject matter. Further, Applicants respectfully request that the objection to claims 22, 24 and 25 should also be withdrawn at least because of their dependencies upon independent claim 19 and for the reasons set forth above.

The Rejection under 35 U.S.C. § 102(e)

Claims 15-17, 26, 32-33, and 48-50 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Kobayashi. To the extent that the rejection might be reapplied to the claims as newly-amended, it is respectfully traversed as being based on a reference that neither teaches nor suggests the novel combination of features recited in the claims.

With respect to independent claims 15, 32 and 48, as newly amended, Applicants respectfully submit that Kobayashi does not teach or suggest the claimed combinations recited in these claims including at least the feature that there is a "a change in optical characteristic of the recording layer where pits are formed with the light as compared to a surrounding annular unrecorded area where pits are not formed, wherein said optical recording medium is a recordable optical disc which is readable by a disc player immediately after recording."

Kobayashi, as described at lines 22-30 of column 11, discloses the formation of a visible image by changing the width of the pits formed on the disk. However, Kobayashi neither teaches nor suggests at least "a surrounding annular unrecorded area where pits are not formed," as recited in the newly-amended claims. Also, Kobayashi discloses a compact disk player 42, but neither teaches nor suggests at least that the compact disk player 42 is capable of reading a recordable optical disk "immediately after recording," as recited in the newly-amended claims. Therefore, for at least the reasons set forth above, Applicants respectfully submit that Kobayashi does not teach or suggest the claimed combinations including at least the feature that there is a "a change in optical characteristic of the recording layer where pits are formed with the light as compared to a surrounding annular unrecorded area where pits are not formed, wherein said optical recording medium is a recordable optical disc which is readable by a disc player immediately after recording," as recited by independent claims 15, 32 and 48, as newly amended.

Accordingly, Applicants respectfully assert that the rejection under 35 U.S.C. § 102(e) should be withdrawn because Kobayashi does not teach or suggest each and every feature of independent claims 15, 32 and 48, as newly amended. As pointed out in MPEP § 2131, "[t]o anticipate a claim, the reference must teach every element of the claim." Thus, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. Of California, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987)." Furthermore, Applicants respectfully assert that the rejection of dependent claims 16, 17, 26, 33 and 49-50

should also be withdrawn at least because of their dependencies upon respective newly-amended independent claims 15, 32 and 48 and for the reasons set forth above.

The Rejection under 35 U.S.C. § 103(a)

Claims 18, 21, 31, 34-37, 42-45, 47 and 51 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kobayashi in view of Nomula. To the extent that the rejection might be reapplied to the claims as newly-amended, it is respectfully traversed as being based on references that neither teach nor suggest the novel combination of features recited in the claims.

As discussed above, Applicants respectfully submit that Kobayashi fails to teach or suggest each and every feature of the claimed combination of independent claims 15, 32 and 48, as newly amended.

For similar reasons as those set forth above, Applicants respectfully submit that Kobayashi also does not teach or suggest the claimed combination of newly-amended claim 47 including at least the feature that there is a “a change in an optical characteristic of the recording layer where pits are formed with the light as compared to a surrounding annular unrecorded area where pits are not formed, and wherein said optical recording medium is a recordable optical disc which is readable by a disc player immediately after recording.”

Nomula is directed to a method and apparatus for providing a graphical image on an optical recording disc. Since Nomula does not cure the deficiencies of Kobayashi as discussed above with regard to newly-amended independent claims 15, 32, 47 and 48,

Applicants respectfully submit that Kobayashi and Nomula, whether taken singly or combined, fail to teach or suggest the above-mentioned features of the instant application.

Accordingly, Applicants respectfully assert that the rejection of independent claim 47 under 35 U.S.C. § 103(a) should be withdrawn. Further, Applicants respectfully assert that the rejection of claims 18, 21, 31, 34-37, 42-45 and 51 under 35 U.S.C. § 103(a) should be also withdrawn at least because of their dependencies upon newly-amended independent claims 15, 32 and 48, as newly-amended, and for the reasons set forth above.

Newly Presented Claims

Applicants have added new claims 56-57 to differently describe the invention. New claims 56-57 are supported at least by the disclosure at the third full paragraph of page 37, the paragraph bridging pages 21 and 22, and the first paragraph of page 25 of the specification. Applicants respectfully submit that new claims 56-57 are allowable over the prior art of record based at least on similar reasons as those set forth above.

With no other rejections pending, Applicants respectfully assert that claims 15-51 and 56-57 are in condition for allowance.

Conclusion

In view of the foregoing remarks, Applicants respectfully request reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution.

Applicants respectfully request a three-month extension. Please charge the amount of \$1122.00 representing \$950.00 for the three-month extension of time fee and \$172.00 for extra independent claim fee to our Deposit Account No. 50-0310.

Except for issue fees payable under 37 C.F.R. §1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0310.

Respectfully submitted,

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By: _____



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